

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

REMARKS

The Applicant respectfully requests entry of the above amendments, and consideration of the application as amended.

By this amendment, the Applicant amended claim 59 to address a clear error in dependency and introduced new claims 63-65. Support for claim 63 is found in Figure 2; support for claims 64 and 65 is found in paragraphs 0027 and 0041. No new matter was introduced.

Claims 1-9, 11, 23-27, 29-39, 41, 42, 55-57, and 59-65

I. Response to Obviousness Rejection Based upon Friend and Burgess

In paragraph 2 on pages 2 through 5 of the Action, the Patent Office rejected claims 1-8, 11, 23-27, 29-38, 42, 56, 57, 59-62 as obvious in view of the combined teachings of U.S. Patent 3,641,966 of Friend [herein "Friend"] and newly cited U.S. Patent 4,211,216 of Burgess, et al. [herein "Burgess"]. The Applicant respectfully submits that these rejections are inappropriate and requests that these rejections be reconsidered and withdrawn based upon the following comments and observations.

First, MPEP section 2104.02 provides the following guidelines when considering the obviousness of a claimed invention in view of the prior art:

In determining the differences between the prior art and the claims, the question under 35 U.S.C.103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious. *Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983) [Emphasis added.]

As discussed in paragraph 0012 of the present specification,

Aspects of the present invention overcome limitations of the prior art by, among other things, allowing the bather to regulate the flow of pressurized water out of one or more water jets without affecting the flow of water out of other water jets.

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

The present invention may control the flow of water jets anywhere in a bathing enclosure, for example, to one or more seats in a spa. [Emphasis added.]

The Applicant submits that neither Friend nor Burgess recognize this problem or provide any means for addressing this limitation of the prior art that is addressed by aspects of the present invention. Therefore, the Applicant respectfully submits that the inventions recited in claims 1, 23, 30, and 35 are not obvious in view of Friend and Burgess.

MPEP 2104.02 also specifies:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria. [Emphasis added.]

The Applicant submits, and as will be discussed further below, neither Friend nor Burgess disclose, teach, or even suggest the claimed invention as a whole. Therefore, the Applicant respectfully submits that the invention recited in claims 1, 23, 30, and 35 are not obvious in view of the teachings of Friend and Burgess.

With respect to the rejections of claims 1, 23, 30, and 35, the Applicant submits that even if the teachings of Friend and Burgess can be combined, the present invention does not ensue. In reviewing Friend, the Applicant agrees that Friend fails to teach the claimed "seat...at an elevation beneath the water." However, the Applicant believes that there are further distinction between Friend and the claimed invention that are not identified by the Patent Office. Specifically, the Applicant submits that Friend also fails to teach or suggest the claimed "foot well" and the claimed "manifold having....a plurality of outlets in fluid communication with the set of water inlets."

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

With respect to the claimed foot well, Friend does not include any structure that corresponds to a "foot well." As described in the present specification and as commonly known in the art, a foot well is a recessed area positioned to accept the feet of the bather. For example, the cited Peterson reference (discussed below) illustrates a typical foot well 24, which is consistent with the use and illustration of a foot well in the present application, as in foot well 52 shown in Figure 2 of the present application. Clearly, Friend discloses no structure of the same shape or function as the claimed foot well. Evidence of Friend's failure to disclose of foot well is provided in the Patent Office's comments where no specific structure in Friend corresponding to the claimed foot well is identified. This is understandable, since Friend provides no such structure. Based upon this failure of Friend alone, the Applicant submits that these rejections are inappropriate and should be withdrawn. However, further distinctions can readily be identified.

With respect to the claimed "manifold having....a plurality of outlets in fluid communication with the set of water inlets," the Applicant submits that this feature is also missing from Friend. The Patent Office identifies "pipe 22" of Friend as the claimed "manifold." The Applicant respectfully submits that according to the claimed invention, the claimed manifold has "a plurality of outlets in fluid communication with the set of water inlets." Under close examination of Friend's pipe 22, the Applicant can identify only a single outlet from pipe 22, not "a plurality," that is "in fluid communication with the set of water inlets" 60, 61 identified by the Patent Office. For example, pipe 22 receives water from pump 21; thus, the bottom of pipe 22 is an inlet, not an outlet. The pipes controlled by valves 24 and 24a (the "diverter valve") are not in fluid communication with inlets 60, 61; therefore, these pipes are not outlets. The tee at the top of pipe 22 receives water from conduits 14 and 16 and discharges water to pipe 18 which may be in fluid communication with inlets 60, 61. Therefore, the Applicant's submits that pipe 22 only has a single outlet to pipe 18, and therefore, pipe 18 does not read on a "manifold having....a plurality of outlets in fluid communication with the set of water inlets."

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

Even if pipe 18 and pipe 22 are deemed to be the claimed "manifold," again, pipes 18 and 22 only have single outlet from pipe 18 that is "in fluid communication with the set of water inlets." New claim 63 further underscores this distinction from Friend by reciting "each of the plurality of outlets of the manifold is in fluid communication with one of the water inlets."

Moreover, Friend clearly does not disclose a manifold as is known in the art and disclosed in the present application. For example, Nicolet (discussed below) illustrates typical manifolds 20 and 31, which are consistent with the use and illustration of a manifold in the present application, as in manifold 26 shown in Figure 1 or manifold 56 shown in Figure 2 of the present application. However, Friend discloses no such manifolds as disclosed and claimed.

Based upon these failures of Friend alone, the Applicant submits that these rejections are inappropriate and should be withdrawn.

As noted by the Patent Office, Friend also fails to teach a "seat...at an elevation beneath the water level" as recited in claims 1, 23, 30, and 35 and relies on Burgess to provide this teaching. As noted by the Patent Office, Burgess discloses an unnumbered seat positioned in a tub 10. However, the Applicant respectfully submits that close examination of Burgess reveals that the seat of Burgess is clearly incompatible with the tub 10 of Friend.

As recited in the Abstract, Burgess discloses a "whirlpool bath designed for use in hospitals...so as to allow the use of trolleys and mobile patient handling equipment..." As clearly illustrated in Figure 2 of Burgess, this is accomplished by providing a tub 10 supported on a base 43 having a recess (unnumbered) that "provides enough space for most hospital patient-handling equipment, such as the device shown in FIG. 2 as 40." (3:14-16). As clearly illustrated in Figure 2 of Burgess, the "seat" identified by the Patent Office is part of the patient-handling equipment 40 of Burgess. In other words,

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

the seat cited by the Patent Office is not a part of the tub 10 of Burgess, but is an ancillary piece of equipment mounted on a transport device and the tub 10 of Burgess is specially designed to accept the patient handling equipment 40, specifically, providing the recess beneath the tub. Therefore, in order to accommodate the seat of Burgess, the tub of Friend would have to be modified to accommodate the equipment 40 of Burgess. Since the tub of Burgess is specially designed to accommodate equipment 40, there is no teaching or suggestion in either Burgess or Friend how the tub of Friend needs to be modified to accommodate the seat and its equipment 40.

As subtitle of section 2143.01 (III) of the MPEP, is significant regarding the inappropriateness of the combination of Friend and Burgess; specifically, this subsection is entitled:

III. FACT THAT REFERENCES CAN BE COMBINED OR MODIFIED IS NOT SUFFICIENT TO ESTABLISH PRIMA FACIE OBVIOUSNESS

The section continues:

The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) ... Although a prior art device "may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so." 916 F.2d at 682, 16 USPQ2d at 1432.). See also *In re Fritch*, 972 F.2d 1260, 23 USPQ2d 1780 (Fed. Cir. 1992). [Emphasis in original.]

The Applicant respectfully submits that since there is no suggestion in either reference to combine the tub of Friend with the patient handling equipment of Burgess, the rejection of claims 1, 23, 30, and 35 as obvious is inappropriate.

For all these reasons, the Applicant respectfully requests that the rejection of claims 1, 23, 30, and 35 as obvious in view of Friend and Burgess be reconsidered and withdrawn.

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

With respect to the rejections of dependent claims 2-8, 11, 24-27, 29, 31-34, 36-38, 42, 56, 57, 59-62, the Applicant submits that these claims are not obvious in view of Friend and Burgess for the same reasons that claims 1, 23, 30, and 35, from which they depend, are not obvious. In addition, aspects of the dependent claims are not disclosed or suggested by Friend or Burgess. For example, with respect to claim 57, neither Friend nor Burgess disclose or suggest that “the at least one manifold comprises a plenum into which the least one inlet discharges water and from which water is distributed to the plurality of outlets.” With respect to claim 59, neither Friend nor Burgess disclose or suggest that “the foot well water inlet is located at a elevation wherein the water introduced to the foot well by the foot well water inlet minimizes the impact of the water introduced via the foot well water inlet on the comfort or bathing experience of a bather.” Of course, having no foot well, neither Friend nor Burgess can teach the invention recited in claim 59. Moreover, even if the inlet though valve 24a of Friend is considered directed to a foot well (which it is not), the flow of water introduced through this inlet will surely undesirably impact the bather, contrary to aspects of the invention. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

II. Response to Obviousness Rejection Based upon Nicollet, Peterson, and Diamond

In paragraph 4 on pages 5 and 6 of the Action, the Patent Office rejected claims 1-9, 11, 23-27, 29-39, 41, 42, and 55-62 as obvious in view of the combined teachings of U.S. Patent 3,964,472 of Nicollet [herein “Nicollet”], U.S. Patent 3,496,579 of Peterson [herein “Peterson”], and U.S. Patent Des. 288,350 of Diamond [herein “Diamond”]. The Applicant also respectfully submits that these rejections are inappropriate and requests that these rejections be reconsidered and withdrawn based upon the following comments and observations.

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

First, the Applicant references the teachings of MPEP 2104.02 cited above concerning the teaching of the cited art “as a whole” and the “suggestion or motivation” found in the references, but does not repeat the passages here for the sake of brevity. The Applicant submits that neither Nicollet, Peterson, nor Diamond teach or even suggest the claimed invention as a whole or recognize the problem addressed by the aspects of the present invention. Therefore, the Applicant respectfully submits that the inventions recited in claims 1, 23, 30, and 35 are not obvious in view of Nicollet, Peterson, and Diamond.

With respect to the rejections of claims 1, 23, 30, and 35, the Applicant submits that even if the teachings of Nicollet, Peterson, and Diamond can be combined, the present invention does not ensue. In reviewing Nicollet, the Applicant agrees that Nicollet fails to teach the claimed “foot well positioned below the elevation.” However, in addition, the Applicant submits that the Patent Office fails to identify “a user-operable diverter” as claimed. For this reason alone, the Applicant submits that these rejections are inappropriate.

Again, the Applicant concurs with the Patent Office that Nicollet does not disclose “a foot well positioned below the elevation” of the seat as claimed. To remedy this deficiency in Nicollet, the Patent Office relies on the foot well 24 of Peterson and the unnumbered foot well in Diamond. However, the Applicant respectfully submits that this combination is inappropriate.

It is well established in the law that it would be inappropriate to combine the teachings of references when their combined teachings interfere with the disclosed function of the references so combined. Again, section 2243.01 of the MPEP is applicable in this regard. Subsection 2143.01 (V) is entitled:

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

V. THE PROPOSED MODIFICATION CANNOT RENDER THE PRIOR ART UNSATISFACTORY FOR ITS INTENDED PURPOSE

and reads:

If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984) ...The court reversed, finding that if the prior art device was turned upside down it would be inoperable for its intended purpose because the gasoline to be filtered would be trapped at the top, the water and heavier oils sought to be separated would flow out of the outlet instead of the purified gasoline, and the screen would become clogged.

The Applicant submits that this rejection of claims of claims 1, 23, 30, and 35 as obvious in view of Nicollet, Peterson, and Diamond is inappropriate based upon the same reasoning above.

A close examination of Nicollet reveals that the disclosed invention provides a specific advantageous function. The Applicant submits that this function would be destroyed if the teachings of Peterson and Diamond were introduced. As described at 1:24-32 of Nicollet:

The present invention [of Nicollet] overcomes the drawbacks of known devices, and further advances the subject matter treated by my above-identified patent, by providing a device which automatically delivers water and air in admixture in jets arranged in a tub specially shaped to relax the user at the same time that it accurately positions the body of the user, the jets being directed in the direction of the venous circulation, that is, toward the heart. [Emphasis added.]

Moreover, at 1:57-66, Nicollet states:

Referring now to the drawings in greater detail, there is shown a device according to the present invention, comprising a tub 1 which is specially shaped to place the user in the most favorable position to receive underwater massage, that is to say, in a relaxed position. To this end, the tub bottom has a double curve: upwardly convex at 2 for the reception of the lower limbs, and upwardly

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

concave at 3 for the reception of the hips and the lower back, the upper back being supported at 4. [Emphasis added.]

That is, the tub of Nicollet is "specially shaped" to elevate the legs above the seat. Therefore, to somehow incorporate the foot wells of Peterson or Diamond at an elevation below the seat of Nicollet would contravene the very intention of the Nicollet design. According to section 2143.01 (V) of the MPEP cited above, this is the exact type of inappropriate combination that the MPEP teaches cannot be the basis for an obviousness rejection. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

With respect to the rejections of dependent claims 2-9, 11, 24-27, 29, 31-34, 39, 41, 42, and 55-62, the Applicant submits that these claims are not obvious in view of Nicollet, Peterson, and Diamond for the same reasons that claims 1, 23, 30, and 35, from which they depend, are not obvious. The Applicant respectfully requests that these rejections be reconsidered and withdrawn.

Application No.: 10/614,312
Amendment dated April 5, 2007
Reply to Office Action of January 5, 2007

CONCLUSION

The Applicant believes that the above Amendment and Remarks place the application in allowable form. An early and favorable action on the merits of the application is requested.

If a telephone conference would be of assistance in advancing prosecution of the subject application, the Applicant's undersigned Agent invites the Examiner to telephone him at the number provided.

Respectfully submitted,



John Pietrangelo
Agent for Applicants
Registration No. 39,331

Dated: April 5, 2007

HESLIN ROTHENBERG FARLEY & MESITI P.C.
5 Columbia Circle
Albany, New York 12203-5160
Telephone: (518) 452-5600
Facsimile: (518) 452-5579